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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,701	03/30/2001	Kenneth W. Aull	15-0225	7427

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,701

Applicant(s)

AULL, KENNETH W.

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2137

DETAILED ACTION

Claims 1-16 have been considered. Examiner maintains the rejection presented in the previous action.

5

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15

Claims 1-2 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi, U.S. Patent No. 5,878,138, in view of Texas DPS (Texas Department of Public Safety). Frequently Asked Questions. October 12, 1999. pages 1-4. Retrieved from the Internet at the following URL: http://web.archive.org/web/20000303141313/www.txdps.state.tx.us/administration/driver_licensing_control/faq.htm).

20

As per claims 1 and 9, the applicant describes a method of preventing ID spoofing of public key infrastructure system in an enterprise comprising the following limitations which are met by Yacobi in view of Texas DPS:

25

a) allowing a user to access a registration server (Yacobi: Col 8, line 50 to Col 9, line 23);
b) upon the registration server receiving identification information from the user and also receiving a request by the user for a new signature certificate, the registration server querying a directory containing reference information of users of the enterprise to obtain information regarding the identified user (Yacobi: Col 8, line 50 to Col 9, line 23);

30

c) and upon the registration server receiving information from the directory indicating that the identified user already possesses a signature certificate, the registration server informing the user that a

Art Unit: 2137

new signature certificate will not be issued until the old signature certificate has been revoked, thereby preventing an unauthorized user from ID spoofing to obtain a valid signature certificate (Yacobi: Col 8, line 50 to Col 9, line 23; Texas DPS: page 1);

5 d) and maintaining a one-to-one correspondence between users of the enterprise and signature certificates (Yacobi: Col 13, lines 1-2);

Yacobi discloses all the limitations of the above claim except for the specific limitation of "informing a user that a new signature certificate will not be issued until the old signature has been revoked". In Yacobi, upon the registration server receiving information that the user who is applying for a new certificate still has a valid certificate, the registration server simply revokes the old certificate as a new certificate is formed in order to satisfy the system's requirement that each valid user has exactly one
10 certificate at any one time (Col 13, lines 1-2).

Texas DPS discloses the idea of informing a user of revocation of a form of identification before issuing a new form of identification. More specifically, Texas DPS discloses the well-known idea that when a user applies for a new form of identification, he is notified that the new form will not be issued until
15 the old form is revoked as he is required by an authority to surrender his valid or expired Driver's License before he receives his new form of identification. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Texas DPS with those of Yacobi and "inform" the user of the surrender so the user is better aware of the process taking place.

20 As per claims 2 and 10, the applicant limits the method of claims 1 and 9, which are met by Yacobi in view of Texas DPS, with the following limitation which is met by Yacobi:

Further comprising providing user identifiers and their corresponding digital signature certificates in said directory (Yacobi: Col 9, lines 10-16).

25 Claims 5-6 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi in view of Vaeth, U.S. Patent No. 6,308,277.

Art Unit: 2137

As per claims 5 and 13, the applicant describes a method of preventing ID spoofing of a public key infrastructure in an enterprise comprising the following limitations which are met by Yacobi in view of Vaeth:

a) allowing a user to access a registration server (Yacobi: Col 8, line 50 to Col 9, line 23);

5 b) upon the registration server receiving identification information from the user and also receiving a request by the user for a new signature certificate, the registration server querying a directory containing the reference information of users of the enterprise to obtain information regarding the identified user (Yacobi: Col 8, line 50 to Col 9, line 23);

10 c) and upon the registration server receiving information from the directory indicating that the identified user is not in the directory, the registration server informing the user that a signature certificate will not be issued, thereby preventing an unauthorized user from ID spoofing to obtain a valid signature certificate (Vaeth: Col 8, lines 41-54);

d) and maintaining a one-to-one correspondence between users of the enterprise and signature certificates (Yacobi: Col 13, lines 1-2);

15 Yacobi discloses all the limitations of the above claim, with the exception that Yacobi does not specifically disclose "informing" a user that a certificate will not be issued. The idea of informing a user that a certificate will not be issued is disclosed by Vaeth. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Vaeth with those of Yacobi because notifying a user that a certificate will not be issued informs the user of an authentication error
20 and gives the user the opportunity to take appropriate action.

As per claims 6 and 14, the applicant limits the method of claims 5 and 13, which are met by Yacobi in view of Vaeth, with the following limitation which is also met by Yacobi:

25 Further comprising providing user identifiers and their corresponding digital signature certificates in said directory (Yacobi: Col 9, lines 10-16).

Art Unit: 2137

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi in view of Texas DPS in further view of Zhou (Zhou, Tao. "Directory Integration and the Metadirectory". July 1999. Windows IT Pro).

5 As per claims 3 and 11, the applicant limits independent claims 1 and 9, which are met by Yacobi in view of Texas DPS, with the following limitation which is met by Zhou:

Further comprising providing an authoritative database including user identifiers, wherein the directory is updated from the authoritative database (Zhou: pages 1-2).

10 However, Yacobi fails to disclose the user of an authoritative database. Zhou discloses the benefit of using directory integration with an authoritative database of user identifiers which he calls a metadirectory. In the second paragraph Zhou writes, "Directory Integration lets network administrators manage directory information from one directory and automate the process of changing information in multiple directories. In the short run, directory integration lowers the cost of directory management because it reduces human involvement in directory management. A comprehensive directory-integration
15 system often requires an enterprise directory to store and unify directory information in a central repository, or metadirectory. In the long run, you can incorporate into a metadirectory new network services—for example, ... public key infrastructure (PKI)< to manage digital certificates for e-commerce".

20 An authoritative database including user identifiers would be an obvious improvement in the system of Yacobi in view of Texas DPS because it would allow one centrally managed database to update various bank sites. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Zhou with the ideas of Yacobi because use of an authoritative database helps to better manage digital certificates as Zhou discloses.

25 Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi in view of Vaeth in further view of Zhou (Zhou, Tao. "Directory Integration and the Metadirectory". July 1999. Windows IT Pro).

Art Unit: 2137

As per claims 7 and 15, the claims are rejected for the same reasons as given in the rejection of claims 3 and 11.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi in view
5 of Texas DPS in further view of Fischer, U.S. Patent No. 5,214,702.

As per claims 4 and 12, the applicant limits the method of claims 1 and 9, which are met by Yacobi in view of Texas DPS, with the following limitation which is met by Fischer:

Further comprising providing a personal revocation authority to revoke a user's previous
10 signature certificate, the personal revocation authority being chosen so as to personally recognize a user (Col 13, lines 46-47);

Yacobi discloses all the limitations of independent claims 1,5,9, and 13. However, Yacobi fails to disclose a person who is a revocation authority in charge of personally recognizing users.

Fischer discloses the ideas that a "certifier may empower another person to cancel other
15 certificates which the certifier has produced" (Col 13, lines 46-47). Fischer discloses the idea that a person, not a computer, can revoke certificates which is absent from Yacobi. Since a person is the revocation authority, he can personally recognize a user.

It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Fischer with those of Yacobi and incorporate the idea of a personal revocation
20 authority to add another element of security into Yacobi's system through personally being able to identify users to prevent ID spoofing.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi in view of Vaeth in further view of Fischer, U.S. Patent No. 5,214,702.

25

As per claims 8 and 16, the claims are rejected for the same reasons as given in the rejection of claims 4 and 12.

Response to Arguments

Applicant's arguments, see Remarks filed 12/1/05, with respect to claims 1 and 9 have been fully considered but they are not persuasive. Examiner has rejected the claims on 103(a) grounds under

5 Yacobi in view of Texas DPS. Applicant presents the following arguments:

1) Texas DPS does not teach "informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked"

2) Examiner has relied on hindsight

3) non-analogous art

10

Examiner respectfully disagrees with the arguments above. Regarding (1), applicant argues that Texas DPS does not teach "informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked" because Texas DPS relates to licenses and not certificates. Examiner respectfully submits that this argument is moot in light of the fact that the Examiner relies on the combination, and not solely Texas DPS, to teach the above cited limitation. Yacobi discloses that a new signature certificate will not be issued until the old signature certificate has been revoked. However Yacobi is silent as to "informing a user" about this procedure. Texas DPS teaches informing a user about a similar identification procedure. Specifically, Texas DPS teaches informing a user that a new form of identification (new license) will not be issued until the old form of identification (old license) has been

15
20 revoked.

20

While Examiner is aware that a license and a certificate are different forms of identification, Examiner has incorporated Texas DPS into Yacobi's system merely for the step of "informing a user". Thus, *the combination* of Yacobi in view of Texas DPS allows for "informing a user" of the identification procedure of Yacobi. Since Examiner relies on the combination, and not solely Texas DPS, to teach the above cited limitation, applicant's arguments that the limitation is not met by Texas DPS are moot.

25

Regarding (2), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is

Art Unit: 2137

in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5 Regarding (3), in response to applicant's argument that Texas DPS is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Texas DPS is in the field of endeavor. Both Texas DPS
10 and the Applicant address identification issuance. Even further, both seek identification issuance to authorized users and to curtail identification spoofing. While Texas DPS and the Applicant's Specification relate to identification issuance of different forms of identification (ie. license and certificate), an argument that the references are non-analogous would be akin to an argument that two encryption methods are not in the same field of cryptography merely because one utilizes symmetric key encryption and the other
15 uses public key encryption.

Applicant further argues that the cited art is not pertinent to the problem either. Examiner disagrees with this argument as well but first notes that since both references have been shown to be related to the same field, the requirement for showing analogous art has already been satisfied. As stated above, both address the problem of curtailing future identification spoofing and both require
20 surrender of an old form of identification. Thus, Texas DPS is reasonably pertinent to the particular problem Applicant solves. Applicant further argues that since a user may get a new license if he loses his old one, it is possible that more than one license may be attained and Texas DPS may not satisfy the claimed limitation of maintaining a one-to-one correspondence between users and forms of identification. To what extent the applicant's statements are true, Examiner respectfully submits that the test for
25 analogous art is not whether a reference satisfies all or any of the limitations of the claimed invention. The test is whether a references is 1) within the same field of endeavor OR 2) reasonably pertinent to the particular problem. Texas DPS is both within the same field of identification issuance and reasonably

Art Unit: 2137

pertinent to the particular problem Applicant solves since both Texas DPS and the Applicant relate to curtailing identification spoofing.

Applicant's arguments with respect to claims 5 and 13 have been fully considered but they are not persuasive. Examiner has rejected the claims under 103(a) grounds in light of Yacobi in view of Vaeth. Applicant presents the following arguments:

1) When claim 5 is read as a whole, it is clear that the user recited in claim 5 does not possess a signature certificate

2) There is no motivation to combine because the combination trades security for convenience

Examiner respectfully disagrees with the arguments above. Regarding 1), applicant argues that when claim 5 is read as a whole, it is clear that the user recited in claim 5 does not possess a signature certificate. Applicant contends that, based on this reading of claim 5, Yacobi cannot meet the limitations of the claimed invention. Examiner respectfully submits that nowhere in claim 5 does applicant preclude the user from possessing a signature certificate. Accordingly, applicant's argument is outside the scope of the claims and does not overcome the rejection.

Regarding 2), applicant appears to be arguing that there is no motivation to combine Vaeth with Yacobi because doing so would create an undesirable trade of security for convenience. Examiner respectfully submits that Applicant may have misinterpreted the combination as applied. Nowhere is any trade of security for convenience proposed or suggested by the combination. Yacobi discloses that a registration server authenticates a user. Yacobi further teaches that, if authenticated, the registration server informs a user that a signature certificate will be issued. However, Yacobi is silent as to what happens when the user is not authenticated. Vaeth discloses the obvious and well-known idea that a user may be "informed" that he is not authenticated. The combination, as applied, merely incorporates the idea of "informing" a user if he is not authenticated. Thus, no security tradeoff, or any tradeoff in general, takes place. Accordingly, applicant's arguments do not overcome the rejection.

Art Unit: 2137

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER